



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,468	04/11/2001	Hideki Fujii	52433/639	7679

26646 7590 11/14/2002

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

WYSZOMIERSKI, GEORGE P

ART UNIT	PAPER NUMBER
----------	--------------

1742

DATE MAILED: 11/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,468

Applicant(s)

MURAYAMA ET AL.

Examiner

George P Wyszomierski

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-9,16-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-9 and 16-25 is/are rejected.
- 7) ☒ Claim(s) 26 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 7-9, and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent 466606.

The EP '606 reference discloses seam welded tubes which may be of a size as recited in the instant claims, and made of an (alpha + beta) titanium alloy. The '606 tubes are made by cold forming a strip followed by a welding step to form the strip into a tube, which may include plasma welding and/or TIG arc welding (see EP '606 pages 5-7). Page 5 of the '606 reference further discloses a step as recited in instant claim 25.

The prior art does not specify that the ratio of the minimum to maximum wall thickness of the '606 tubes is between 0.95-0.99, as required by the instant claims. However, clearly one of ordinary skill in the pipe-making art wants to produce as uniformly sized tube as possible. Further, the materials used and the process steps performed in the '606 reference may be the same as those employed in the claimed invention. The examiner's position is that performing a specific set of process steps upon a specific material would result in substantially the same product in either the '606 disclosure or in the present invention.

Consequently, a prima facie case of obviousness is established between the EP '606 disclosure and the presently claimed invention.

3. Claims 2-5 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent 466606, as above, in view of either Shida et al. (U.S. Patent 4,859,415) or Meredith et al. (U.S. Patent 5,226,981).

The pipes and methods described in the EP '606 reference employ an alloy containing an amount of platinum group metals as recited in instant claims 3, 5, 17, and 19. The '606 alloys do not contain aluminum. Both Shida et al. and Meredith indicate that it is conventional in the art to employ either a Ti-6Al-4V or a Ti-3Al-2.5V ($\alpha + \beta$) alloy in the seam welded pipe making art (see Meredith column 3, lines 29-31 or Shida Table 1, particularly examples 59-61 therein). The Shida alloys further employ the platinum group metals as done by EP '606 and as recited in present claims 3, 5, 17, and 19. Because all of the above references are seeking to produce highly corrosion resistant seam welded pipes, it would have been an obvious expedient for one of ordinary skill in the art to utilize an alloy composition as recited in the Shida or Meredith patents in the tubes and methods as described by EP '606.

4. In a response filed October 7, 2002, Applicant alleges that the claimed invention can be distinguished from that of EP '606 in that the prior art material comprises an α matrix material as opposed to the presently claimed $\alpha + \beta$ material, and/or that certain characteristics or limitations of the Shida and Meredith references regarding pipe characteristics are distinct from those presently claimed. Applicant's arguments have been carefully considered, but are not persuasive of patentability because:

a) It is unclear on what basis applicant asserts that the material in the EP '606 reference is an alpha phase material. Even if the initial material is alpha phase, the examiner notes that the '606 process involves hot rolling above the beta transus point, prior to any welding or other

tube forming steps. Thus, one of skill in the art would have reason to believe that a two-phase ($\alpha + \beta$) material is made into pipe in the prior art process.

b) With regard to Shida and Meredith, these references are applied largely for their teachings of the use of certain alloying elements (e.g. aluminum and vanadium) in titanium alloys to be formed into pipe materials. All pipe-related limitations in the instant claims (e.g. cold forming, welding, etc) are disclosed by EP '606 or, as stated in the rejection supra, do not patentably define over the '606 reference (e.g. min/max thickness ratio).

5. Claims 26 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 1742

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (703) 308-2531. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (703) 308-1146. The fax phone number for this Group is (703) 872-9310. The Right fax number for this examiner is (703) 872-9039. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.


GEORGE WYSZOMIERSKI
PRIMARY EXAMINER

GPW
November 12, 2002